

Remarks

This amendment is responsive to the official action of November 29, 2007 and is accompanied by a Petition for retroactive extension of time.

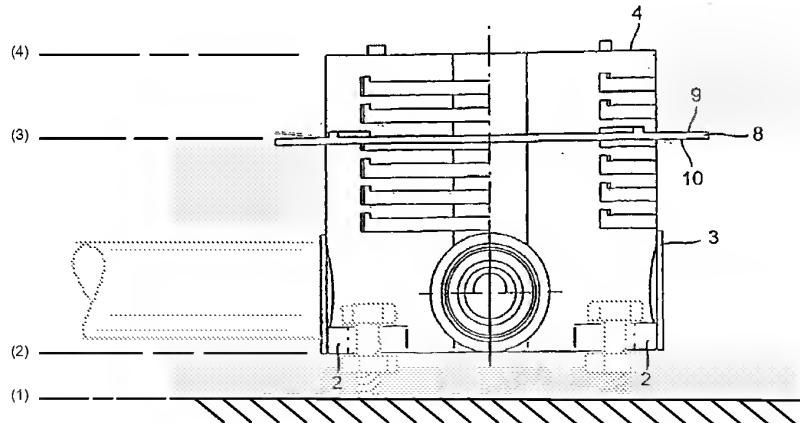
Applicant is pleased to note that claims 7-9, 17 and 18 have been allowed. Objection was made to Claim 16 as having an erroneous status indicator ("currently amended"), which should have read - - previously presented - -. This correction has been made in the listing of claims now submitted.

Claim 1 and the claims depending from claim 1 were subject to two rejections under 35 U.S.C. §103, one being a combination of US 6,129,109 – Humber and 5,326,060 – Chubb and the other being a combination of 754,414 – Bossert and 5,466,886 – Lengyel. Claim 1 has been amended to more particularly recite a substantial and basic difference between applicant's invention and any one or any combination of aspects from the four cited references. Applicant's flush mounting box is arranged to provide a flange that is spaced back from the edge at the open front of the box. In the prior art references relied upon in combination, the flange is spaced out in front of the edge at the open front of the box. The prior art references concern mounting at spaced opposite faces of panels or pours of variable thickness. The prior art does not address how to handle a box that is mounted to a fixed base at the rear and has a flange that is variably spaced back from its open front edge for defining a surface that may bear against the front or back of a facing layer.

Two references of record from earlier in the prosecution of this application are examples of prior art references that have a flange that at least in some embodiments is spaced rearwardly from the edge of the open front of a box. These are 4,053,082 – Ullman and 2,143,517 – Huff. However these references do not show the applicability of such a structure to a situation where a box is fixed in position relative to its rear, namely the normally-closed bottom side. Ullman and Huff do not relate the bottom side of the box to the flange and to the edge at the open front.

There is no basis to assert that a person of ordinary skill would perceive any benefit, let alone a probability of a successful result, from putting a variably placed flange on a box from the prior art, where the problem also has the constraint of a base structure, namely the problem that applicant addresses by the combination of a box with mounting eyes and a flange that is variably spaced rearwardly of the edge at the open front of the box.

In the context of applicant's claimed invention, there are several pertinent elevations. The person of ordinary skill would have to recognize and to consider at least three at the same time. There is no reason to believe that this is within the level of ordinary skill. Applicant's pertinent structures and elevations (see illustration below) include a rear structure (1) to which the box is structurally affixed; the elevation (2) of the bottom of the box (which may be the same as that of the outwardly protruding eyes) where the structural attachment to the box is made relative to the rear mounting surface; the elevation (3) of the top or bottom side of the flange; and the further elevation (4) of the edge of the open front of the box.



It is an aspect of applicant's invention that the inventive flush mounting box can comply with variations in the positions and thicknesses of underlying, coextensive and facing structures. Applicant's box accommodates variability in the

thickness and positioning of facing and other structures, because the claimed structure has the capacity to coordinate variations in the spacing between several such elevations.

By comparison, the prior art deals only with facing structures of variable thickness, which is to say, variations in the spacing between two surfaces or elevations only. See, for example, Humber, where the issue is a variable thickness of the wallboard overlying the box and underlying the cover plate 42. Also see Chubb, where the problem is to match the thickness of the corrugated siding 5. In these arrangements, the cover plate is spaced out to the front and away from the edge at the open front of the box by a variable distance. The references cited (Humber, Chubb, Bossert, Lengyel), individually or in combination, do not meet the invention claimed as a whole because they lack a flange placed at a variable distance back (rearwardly) from the edge of the open front of the box. Claim 1 as amended particularly recites this distinction. Furthermore, there is no suggestion of any structure or function corresponding to the at least three distinct levels of concern to applicant.

Applying *Graham v. John Deere*, the content of the prior art is seen in the cited references. The prior art lacks a similar box arrangement that has eyes protruding outwardly and a flange spaced a variable distance to the rear of the edge of the open front of a box. One can look back into other prior art cited during the prosecution of this application, such as Ullman and Huff, and find rearward spaced flanges, but not in a box as claimed, namely mounted to a fixed base structure using eyes protruding outwardly. The level of ordinary skill in the art is represented by several references that are concerned with flanges or elevations that correspond to the opposite faces of a facing structure, such as Chubb's siding or Humber's wallboard. These references show that the level of ordinary skill is sufficient to accommodate panel thickness only.

Thickness is the spacing between two parallel surfaces. The claimed invention is more than that.

In one of the references, namely Lengyel, the box is base mounted. The box is placed so that the front edge of the box is at the elevation of poured concrete. Again, the issue is the thickness of the layer of concrete, i.e., the distance between two elevations and not the relationship of the box, its base mounting, the flange elevation and the front edge elevation, which are three elevations. The person of ordinary skill has no expectation that there is anything to be gained by worrying about a third elevation in a device that is mounted or abutted at one elevation (such as a surface of the flange) so as to cause a spaced part (such as the front edge) to be flush with another elevation. There is no showing of record that the person of ordinary skill would consider a problem to exist. There is no expectation of a probability of successful solution to a problem where no problem is perceived to exist. For these reasons, the differences between the invention defined in claim 1 and the prior art are such that the subject matter claimed as a whole is not shown to have been obvious.

Applicant is pleased to note the allowance of claims 7-9, 17 and 18. Claim 1 is believed allowable as now amended. The remaining claims depend directly or indirectly from claim 1. Applicant requests reconsideration and allowance of all the pending claims, 1-4, 7-10, 12 and 15-18.

Respectfully submitted,

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/Stephan Gribok/
Stephan P. Gribok, Reg. No. 29,643
Duane Morris LLP
30 South 17th Street
Philadelphia, PA 19103-4196
tel. 215-979-1283
fax. 215-979-1020
spgribok@duanemorris.com

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